

DETAILED ACTION

Current Status of 10 / 527821

1. The rejection under 35 U.S.C. 112 1st paragraph is overcome by the amendment filed 11/15/2007.
2. The objections to the specification are overcome by the amendment filed 11/15/2007.
3. The obviousness-type double patenting rejection is obviated because the two copending applications were filed after the instant application.
4. Because the product is considered novel, the withdrawn claims are being rejoined with the compound and methods of use claims.
5. Currently, claims 2-4, 7-23 are currently pending in the instant application and are being examined in the current office action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 11, the phrase "art-known transformation reactions" is unclear. What reactions are referred to? In claim 12, variable Z can be any moiety, not just Z¹. What moiety besides Z¹ is being referred to?
8. Regarding claim 12, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Allowable Subject Matter

9. Claims 2-4, 7-10, are 14-23 are allowed.

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10. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: Janssen et al. (WO 97/16440, published 9 May 1997) teach compound 17 on page 36. This compound fails to anticipate or render obvious compounds of claim 14 because variable L is CH₂-phenyl, not piperidine.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noble Jarrell whose telephone number is (571) 272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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